

## REMARKS

Applicant appreciates the thorough examination of the present application as reflected by the non-final Office Action of August 6, 2009 (hereinafter, the "Office Action"). Applicant responds herein to each of the issues raised in the Office Action, and respectfully submits that the present application is in condition for allowance for at least the reasons discussed below.

### **The Rejections Under 35 U.S.C. § 101**

Claims 11-14 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter because the claims are neither "tied to another statutory class" nor "transform[ing] underlying subject matter ... to a different state or thing." Office Action, page 2. In response, Applicant has amended Claim 11 to clarify that the steps recited therein are carried out "using a programmed computer processor circuit." Applicant respectfully submits that Claim 11, as amended, is sufficiently tied to a particular machine to qualify as statutory subject matter under § 101. Moreover, Claim 11 recites "generating ... a customer electronic invoice ... from the CMR electronic invoice," and, thus, positively recites that subject matter (the CMR electronic invoice) is being transformed to a different state or thing (a customer electronic invoice). Accordingly, Applicant respectfully requests that the rejection of Claims 11-14 under § 101 be withdrawn as obviated.

Claims 31-33 and 49-52 stand rejected under 35 U.S.C. § 101 because "they merely recite a computer program product for use with a computer." Office Action, page 2. Applicant respectfully notes to the contrary that Claim 31 recites a "module," which Applicant's Specification expressly defines as "an embodiment combining software and [computer] hardware aspects." Applicant's Specification, paragraph [0022]. Applicant, thus, respectfully submits that, even under the broadest reasonable interpretation, Claim 31 is directed not to "a computer program product for use with a computer," but rather to a system including computer hardware components. Accordingly, Applicant respectfully submits that Claim 31-33 are directed to statutory subject matter under § 101, and requests that the rejections of Claims 31-33 be withdrawn for at least these foregoing reasons.

With respect to computer program product Claims 49-52, the Office Action states that "[i]n order to be properly claimed, the computer program code must be embodied in a static medium and it must be computer- or machine-executable," and further that "there are

possible interpretations for the claimed computer program product as being a more abstract and fleeting product, such as a carrier wave or signal.” Office Action, page 2. Applicant, however, respectfully notes that Claim 49 expressly recites “a computer usable storage medium having computer-readable program code embodied in the medium” (emphasis added). Applicant respectfully submits that the “computer usable storage medium” recitations of Claim 49 cannot be reasonably read to encompass “a carrier wave or signal,” which one of skill in the art would understand are examples of transmission media, not storage media. Applicant further respectfully submits that one of skill in the art would understand “computer-readable program code” to be code executable by a computer processor to perform the recited functionality. For at least these foregoing reasons, Applicant respectfully submits that Claims 49-52 are directed to statutory subject matter under § 101, and requests the withdrawal of the § 101 rejections.

#### **The Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 31-48 and 49-52 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite, because “[s]ystem/apparatus claims are defined by their structure elements and any corresponding functionality,” and “‘module’ and ‘computer-readable program code’ do not impart structure.” Office Action, page 3. However, as noted above, Applicant’s Specification, in describing some embodiments, expressly defines “module,” as recited by Claim 31, to be “an embodiment combining software and [computer] hardware aspects.” Applicant’s Specification, paragraph [0022]. Applicant respectfully submits that one of skill in the art would be readily able to ascertain the scope of Claim 31 based on the recitations of Claim 31 and Applicant’s Specification. Applicant further submits with respect to Claims 49-52 that, while “computer-readable program code” may not impart structure, as asserted by the Office Action, Claim 49’s recitation of “computer usable storage medium having computer-readable program code embodied in the medium” does impart sufficient structure to satisfy the definiteness requirements § 112, second paragraph. Applicant, thus, respectfully submits that Claims 31-48 and 49-52 satisfy the definiteness requirement of § 112, second paragraph, and accordingly request withdrawal of these § 112 rejections.

Claims 11, 31, and 49 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite because “it is not clear whether ‘and/or’ means ‘and’ or ‘or’ and whether ‘credit/debit’ means ‘credit or debit.’” Office Action, page 3. The Office Action

further asserts that Claims 11, 31, and 49 are indefinite because “[i]t is unclear what system/apparatus/machine does the ‘electronic linked image’ link to.” Office Action, page 3. In response, Applicant has amended Claims 11, 31, and 49 to change all occurrences therein of the phrase “and/or” to simply “or.” Applicant notes that the term “or,” as used in amended Claims 11, 31, and 49, is understood to refer to either or both of the named alternatives, and, therefore, the amendments to Claims 11, 31, and 49 do not change the scope of the claims. Applicant further respectfully submits that the term “credit/debit form,” as recited by Claims 11, 31, and 49, is a term of art which one of skill in the art would understand to refer to a type of accounting form on which either credits or debits, or both, may be indicated or authorized. *See, e.g.*, the sample form provided online at <<http://www.samplewords.com/formspdf/pro-credit-form.pdf>>. Finally, Applicant respectfully notes that paragraphs [0006] and [0007] of Applicant’s Specification, in describing some embodiments, makes clear that “[t]he electronic image and the electronic invoice are electronically linked,” such as, for example, “by generating a hyperlink to the electronic image in the electronic invoice.” Applicant’s Specification, paragraphs [0006]-[0007]. Accordingly, Applicant respectfully submits that Claims 11, 31, and 49, as amended, satisfy the definiteness requirements of § 112, second paragraph, and requests the withdrawal of the § 112 rejections of Claims 11, 31, and 49 for at least these foregoing reasons.

### **The Rejections Under 35 U.S.C. § 103**

Claims 11-14, 31-33, and 49-52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,099,837 to Weibel (“Weibel”) in view of the following secondary references: (1) Applicant’s Background of Invention; (2) Official Notice; (3) U.S. Patent No. 5,717,939 to Bricklin et al. (“Bricklin”); (4) U.S. Patent No. 6,282,552 to Thompson et al. (“Thompson”); (5) U.S. Patent Application Serial No. 2002/0010664 to Rabideau et al. (“Rabideau”); and (6) U.S. Patent No. 6,883,000 to Gropper (“Gropper”). Office Action, page 4. Applicant respectfully traverses the § 103 rejections, for at least the reasons discussed in detail below.

### **Independent Claims 11, 31, and 49 Are Patentable over the Cited References**

Applicant notes that the present Office Action fails to address Applicant’s arguments for the patentability of Claims 11, 31, and 49 presented in Applicant’s Amendment

Accompanying Request for Continued Examination, filed April 9, 2009, and referred to hereinafter as "Applicant's RCE." In Applicant's RCE, Applicant argued that the incorporation of the spreadsheet described by Bricklin into the system described by Weibel would destroy the intended operability of the Weibel system, and, in fact, by describing in detail the linking of a detailed advertisement image document and a separate invoice digital document as opposed to an electronic spreadsheet, Weibel actually teaches away from the use of an electronic spreadsheet for an invoice. Applicant's RCE, page 10. Consequently, Claims 11, 31, and 49 are not obvious under § 103, in part because one of skill in the art would not contemplate integrating the teachings of Weibel with those of Bricklin. Applicant's RCE, page 10. The Office Action, however, fails to note Applicant's argument regarding Weibel's teaching away from the claimed subject matter, and fails to explain how the test for obviousness could be satisfied where one of the references teaches away from the combination. Instead, the Office Action repeats its earlier rejection of Claims 11, 31, and 49, based in part on the combination of Weibel and Bricklin (Office Action, pages 5-6), and notes merely that the "Examiner disagrees" with Applicant's argument that "incorporation of a spreadsheet would [destroy] the intended operability of Weibel" (Office Action, page 9). The Office Action has failed to shoulder the burden imposed by MPEP § 707.07(f) ("[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.") (emphasis added). Accordingly, Applicant respectfully submits that the Office Action has provided no basis for maintaining its rejection of Claims 11, 31, and 49, and that Claims 11, 31, and 49 are patentable over the cited references for at least these foregoing reasons.

Applicant further respectfully submits that the seven references noted above, considered either alone or in combination, fail to disclose or suggest all of the recitations of Claims 11, 31, and 49. For instance, Claim 11 recites, in part, "sending ... an electronic CMR credit/debit form to the business directory publisher that indicates that an error was made in the CMR electronic invoice for the business directory advertisement ... in response to detecting the error." In rejecting Claim 11, the Office Action relies on column 36, lines 32-33 of Gropper as teaching "ads in digital form," and further cites column 34, lines 40-44 of Gropper as disclosing "displaying a message indicating errors (Z errors) and provide the user opportunity to resolve errors, correct incomplete data transmissions." Office Action, page 7. However, the Office Action erroneously implies that the "errors" referenced in

column 34 of Gropper are related to the “ads in digital form” discussed in column 36 of Gropper. In actuality, the “errors” referenced in column 34 of Gropper have nothing to do with errors in the ads themselves, but rather refer to data transmission errors that may occur during a communication session between client computer **100** and server system **130**. See Gropper, column 34, lines 39-44 (“notifying the user of successful completion of the communications session including, for example, displaying a message to the user such as ‘x contacts and y bytes successfully downloaded, z errors’, etc. and provide the user with the opportunity to resolve errors, correct incomplete data transmissions, etc. should errors occur.”). The cited portions of Gropper contain no disclosure or suggestion of “sending an electronic CMP adjustment form ... that indicates that an error was made in the business directory advertisement ... in response to detecting the error,” as recited by Claim 11, and the Office Action provides no other citations to any of the seven cited references as disclosing or suggesting the above-quoted recitations of Claim 11.

Moreover, in rejecting Claims 11, 31, and 49, the Office Action reiterates that the bare statement in Rabideau, paragraph **[0005]**, that “the error notification is often called an invoice or debit memo” discloses the “sending an electronic CMR credit/debit form ... that indicates that an error was made in the CMP electronic invoice for the business directory” recitations of Claim 11. Office Action, page 6. The Office Action justifies this ground for rejection by asserting that “the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.” Office Action, page 9. However, the “invoice or debit memo” referenced by Rabideau simply does not perform the same function as the electronic CMR credit/debit form recited by Claim 1. Rabideau makes clear that the “invoice or debit memo” described therein is a notification generated by an auditing process that flags instances where airline ticketing and fare rules have not been complied with. Rabideau, paragraph **[0005]**. Rabideau makes no mention whatsoever of the “invoice or debit memo” being used to indicate errors made in an electronic invoice. Furthermore, the mere fact that both Rabideau and Claim 1 use the terms “invoice” and “debit” is insufficient evidence that Rabideau somehow discloses the above-quoted recitations of Claim 11.

Finally, in addition to relying on the above-noted portions of Gropper and Rabideau, the Office Action further asserts that “applicant admits in the Specification page 11-12 that ‘CMR credit/debit memo and electronic CMR adjustment form are commonly used in

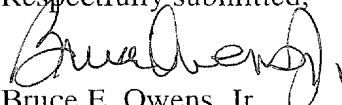
business directory advertising,” and, thus, that it would have been obvious to modify the teachings of Weibel to include sending an electronic CMR credit/debit form indicating that an error was made in the CMR electronic invoice, and sending an electronic CMR adjustment form indicating that an error was made in the business directory advertisement. Office Action, page 7. However, as noted in Applicant’s RCE, Applicant respectfully submits that Claims 11, 31, and 49 are not obvious because a large number of old elements are combined in the independent claims in a unique way to provide unique advantages in the field of business directory advertisement billing, in which tear pages have been used for many years in billing between a business directory publisher, third party advertisement sellers referred to as Customer Marketing Representatives (CMRs), and the customers of the CMR.

Accordingly, for at least these foregoing reasons, Applicant respectfully submits that Claim 11, as well as the dependent claims thereof, are patentable over the cited references. Applicant further respectfully submits that Claims 31 and 49, and the claims depending therefrom, are patentable over the cited references for at least the reasons discussed above with respect to the patentability of Claim 11, based on recitations substantially similar to those of Claim 11.

### **Conclusion**

Applicant again appreciates the Examiner’s thorough examination of the present application. Applicant, however, has demonstrated that the cited references, either alone or in combination, fail to disclose or suggest all of the recitations of the present claims. Accordingly, Applicant respectfully requests allowance of the claims and the passing of the application to issue. If the Examiner believes that a telephone interview would facilitate allowance of the above-noted claims, the Examiner is encouraged to contact the undersigned at (919) 854-1400.

Respectfully submitted,

  
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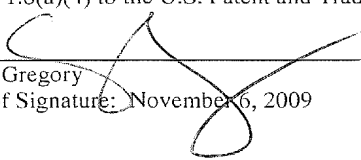
In re: Desai  
Serial No.: 10/617,959  
Filed: July 11, 2003  
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**Customer Number 39072**

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Carey Gregory

Date of Signature: November 6, 2009